

REMARKS

Summary of Office Action

Initially, Applicants note that the Examiner has again failed to indicate consideration of the Information Disclosure Statement filed April 10, 2006 by returning a signed and initialed copy of the Form PTO-1449 submitted therein. Accordingly, the Examiner is again respectfully requested to return a signed and initialed copy of the Form PTO-1449 submitted in the Information Disclosure Statement filed April 10, 2006 with the next official communication.

Applicants note with appreciation that all claim rejections made in the previous Office Action have been withdrawn.

Claims 64-75, 78, 87-92 and 99-104 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kantner et al., U.S. Patent No. 6,433,073 (hereafter “KANTNER”) in view of Kim et al., U.S. Patent No. 6,372,876 (hereafter “KIM”) and further in view of the Handbook of Cosmetic Science and Technology (hereafter “HANDBOOK”).

Claims 77, 79-86, 94-98 and 105-109 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over KANTNER in view of KIM and HANDBOOK and further in view of Koch et al., U.S. Patent No. 6,258,963 (hereafter “KOCH”).

Claims 76 and 93 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over KANTNER in view of KIM and HANDBOOK and further in view of Gers-Barlag et al., U.S. Patent No. 5,725,844 (hereafter “GERS-BARLAG”).

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested in view of the following remarks.

Response to Rejections under 35 U.S.C. § 103(a) over KANTNER in View of KIM and HANDBOOK

Claims 64-75, 78, 87-92 and 99-104 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over KANTNER in view of KIM and HANDBOOK. The rejection alleges that KANTNER discloses oil-in-water cosmetic compositions which comprise a film-forming polyurethane and have properties such as water-resistance and transfer resistance. The rejection further points to Tables XVI and XVII in column 27 of KANTNER in this regard. The rejection concedes that KANTNER fails to explicitly teach the K-values and the glass transition temperatures of the polyurethanes recited in the present claims (and also fails to teach microemulsions). In this regard, the rejection relies on KIM (and HANDBOOK) and essentially alleges that KIM discloses polyurethanes which are soluble or dispersible in water as aids in cosmetic compositions and have K values and glass transition temperatures that meet the recitations of the rejected claims. The rejection further asserts that it would have been obvious to one of ordinary skill in the art to employ the polyurethanes of KIM in the compositions of KANTNER because both KANTNER and KIM allegedly are directed toward water soluble/dispersible polyurethanes for use in cosmetics and because of the expectation of achieving a sunscreen product that is resistant to humidity or water.

Applicants respectfully traverse this rejection. In particular, a closer look at the polyurethanes of KANTNER and the polyurethanes of KIM reveals that the latter polyurethanes

are stated to have properties which make them appear unsuitable for the cosmetic preparations of KANTNER, wherefore there is no motivation for one of ordinary skill in the art to employ the polyurethanes of KIM in the cosmetic preparations of KANTNER, contrary to what is alleged in the present Office Action.

Specifically, according to col. 1, lines 5-7 of KANTNER, the invention described therein pertains to a cold seal adhesive composition in the form of a stable polyurethane dispersion in an alcohol water system. Further, in col. 5, lines 6-51 KANTNER states (emphases added):

An advantage of the inventive composition is the use of an oligomeric alcohol insoluble polyactive hydrogen compound. Because of its hydrophobic nature, such compound provides faster drying and improved hydrolytic stability over prior art synthetic cold seal adhesives. A further advantage of the inventive composition is that it possesses adhesion to low energy substrates similar to that provided by natural rubber-based cold seal adhesives, but without the disadvantages associated with such adhesives. Those disadvantages include discoloration, unpleasant odor, undesirable foaming in wet form, hypersensitivity, and possibility of anaphylactic shock due to the presence of natural latex proteins.

Yet another advantage of the inventive composition is that it has low viscosity and fast drying characteristics in addition to exhibiting self adhesion properties. Thus, the composition is suitable for use as a saturant in processes for preparing cohesive elastomeric bandages

A further advantage of the inventive composition is its ability to form hydrophobic films making it useful in cosmetic applications. Such applications require some amount of water resistance, transfer resistance, or substantivity to skin, nails or hair. The applications include, e.g., makeup cosmetic or protective cosmetic applications such as mascara, foundation, rouge, face powder, eyeliner, eyeshadow, insect repellent, nail polish, skin moisturizer, skin cream and body lotion, lipstick, and sunscreen.

When the inventive dispersion is used in hair care products, such as shampoos and conditioners and the like, the dispersion can provide faster drying. It can also improve the humidity resistance of hair styling agents when used at low levels in combination with other hair styling resins.

In comparison, the cosmetic polyurethane solutions or dispersions of KIM are intended for use in hair treatment compositions in the form of hair setting preparations or sprays which are used for setting, improving the structure and shaping the hair. For example, all of the exemplary

compositions which are described in col. 8 of KANTNER are hair setting compositions, and claims 1-3 are directed to a method of treating hair (independent claim 6 is directed to a method of coating or binding a pharmaceutical composition). Further, in col. 1, lines 36-54 KIM states (emphases added):

In cosmetics, hair-treatment compositions which are, for example, in the form of setting preparations or sprays are used for setting, improving the structure and shaping the hair. These compositions are composed mainly of a solution of film-forming resins or synthetic polymers. The following film formers have hitherto been mainly used in such compositions: shellac, homo- and copolymers of N-vinylpyrrolidone, copolymers of vinyl ethers and maleic monoesters, of (meth)acrylic acid or the esters and amides thereof and crotonic acid with vinyl esters.

The hair-treatment compositions are applied to the hair by spraying in the form of solutions, preferably in ethanol. After the solvent has evaporated, the hair is held in in [sic] the desired shape by the polymer remaining at the points of contact. The polymers must, on the one hand, be sufficiently hydrophilic to be washed out of the hair but, on the other hand, be hydrophobic so that hair treated with the polymers retains its shape and does not become sticky even when the humidity is high.

Accordingly, the above passages of KANTNER and KIM make it clear that the polyurethanes described in these two documents show conflicting properties. For example, while the polyurethanes of KANTNER, when used in cosmetic compositions, must be sufficiently hydrophobic so that they are not washed off when the skin or the hair comes into contact with water (otherwise these polyurethanes would not be able to provide water resistance or substantivity to skin, nails or hair), the polyurethanes of KIM must be “sufficiently hydrophilic to be washed out of the hair”.

Further, according to KIM the polyurethanes disclosed therein must not make the hair sticky even when the humidity is high. In contrast, the polyurethanes of KANTNER must show a certain degree of stickiness as evidenced, e.g., by the fact that they are suitable for use in cold seal adhesive compositions (see also the peel values set forth in Tables V and IX for the polyurethanes of Examples 16 and 36 which are used in all of the Cosmetic Examples of {P29685 00276245.DOC})

KANTNER). This stickiness would appear to explain that KANTNER mentions that the polyurethanes described therein can also improve the humidity resistance of hair styling agents (which appear to include hair setting compositions such as those disclosed in KIM), but only “when used at low levels in combination with other hair styling resins”.

In view of the foregoing differences, it is no coincidence that the polyurethane containing hair treatment compositions of KANTNER, i.e., shampoos, conditioners and the like (see, e.g. the compositions of Cosmetic Examples 7 to 19 of KANTNER), are very different from the hair treatment compositions of KIM, i.e., hair setting compositions such as hair sprays.

For example, a polyurethane which is used in a shampoo must be capable of adhering, in the presence of significant amounts of water, to hair in order to impart substantivity thereto (a desired property of the polyurethanes of KANTNER). In contrast, a polyurethane used for a hair setting composition such as, e.g., a hair spray must be capable of being washed out when the hair is rinsed with water (a desired property of the polyurethanes of KIM).

Further, the ability of the polyurethanes of KIM of being readily rinsed off by water clearly is an undesirable property if these polyurethanes are to be used for a waterproof sunscreen or insect repellent composition such as, e.g., the oil-in-water emulsion of Cosmetic Example 1 of KANTNER.

At any rate, it is pointed out that, while KIM refers broadly to cosmetic compositions, hair treatment compositions and in particular, hair setting compositions are the only cosmetic compositions that are specifically described in KIM. The only other use of the polyurethanes of KIM that can be considered to be described therein is that as a coating and binding agent for pharmaceuticals (see, e.g., claim 6 of KIM). In contrast thereto, KANTNER does not appear to

mention any potential use of the polyurethanes described therein in the pharmaceutical field, let alone as coating or binding agents.

To sum up, for at least all of the foregoing reasons one of ordinary skill in the art would not be motivated to use the polyurethanes of KIM in the compositions of KANTNER. In fact, the mutually exclusive characteristics of the polyurethanes set forth in KANTNER and KIM even constitute a disincentive for one of ordinary skill in the art to combine the teachings of these two documents.

In view of the foregoing, it is submitted that KANTNER in view of KIM (and HANDBOOK) fails to render obvious the subject matter of any of the instant claims. Accordingly, the rejection of claims 64-75, 78, 87-92 and 99-104 under 35 U.S.C. § 103(a) over KANTNER in view of KIM and further in view of HANDBOOK is unwarranted and should be withdrawn, which action is respectfully requested.

Response to Remaining Rejections under 35 U.S.C. § 103(a)

Claims 77, 79-86, 94-98 and 105-109 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over KANTNER in view of KIM and HANDBOOK and further in view of KOCH. Further, claims 76 and 93 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over KANTNER in view of KIM and HANDBOOK and further in view of GERS-BARLAG.

Applicants note that all of the above rejections are based on, *inter alia*, KANTNER in view of KIM (and HANDBOOK) and that all of the rejected claims are dependent, directly or indirectly from independent claims 64, 87 and 99. As is set forth in detail above, the rejection of independent claims 64, 87 and 99 as being allegedly unpatentable over KANTNER in view of

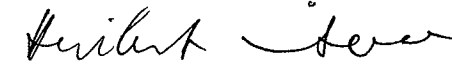
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KIM (and HANDBOOK) is without merit, which automatically applies also to all of the claims which are dependent from claims 64, 87 and 99. In view thereof, Applicants refrain from commenting on any of the allegations which are set forth in the present Office Action with respect to claims 76, 77, 79-86, 93-98 and 105-109. It is pointed out however, that Applicants' silence in this regard is by no means to be construed as admission that any of these allegations is meritorious.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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